

REMARKS

This is a full and timely response to the outstanding Office action mailed November 22, 2004. Upon entry of the amendments in this response claims 1-34 are pending. More specifically, claims 1, 2, 3, 5-11, 13-15, 17, 19-25, 27-30 and 32-34 are amended. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application.

I. Present Status of Patent Application

Claims 20 and 21 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 2, 15, and 16 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Johnson *et al.* (U.S. Patent No. 5,694,616). Claims 9, 13, 14, 23, 27, and 28 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Gupta (U.S. Published Application 2002/0194341). Claims 3 and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johnson *et al.* (U.S. Patent No. 5,694,616) in view of Shaw *et al.* (U.S. Patent No. 6,247,045). Claims 4 and 18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johnson *et al.* (U.S. Patent No. 5,694,616) in view of Collins *et al.* (U.S. Published Application 2002/0013817) hereinafter Collins. Claims 5, 19, and 29 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johnson *et al.* (U.S. Patent No. 5,694,616) in view of Thorne *et al.* (U.S. Patent 5,958,005). Claims 6, 7, 20, and 21 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johnson *et al.* (U.S. Patent No. 5,694,616) in view of Gupta (U.S. Published Application 2002/0194341). Claims 8 and 22 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johnson *et al.* (U.S. Patent No. 5,694,616) in view of Applicant Admitted Prior Art (AAPA). Claims 10 and 24 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gupta as applied to claims 9 and 23 above in view of Applicant Admitted Prior Art (AAPA). Claims 11 and 25 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gupta as applied to claims 9 and 23 above in view of Shaw *et al.* (U.S. Patent 6,247,045). Claims 12 and 26 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gupta as applied to

claims 9 and 23 above in view of Collins *et al.* (U.S. Published application 2002/0013817). Claim 30 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johnson and Thorne as applied to claims 29 and 23 above in view of Shaw *et al.* (U.S. Patent 6,247,045). Claim 31 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johnson and Thorne as applied to claim 29 in view of Collins *et al.* (U.S. Published Application 2002/0013817). Claims 32 and 33 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johnson and Thorne as applied to claim 29 in view of Gupta (U.S. Published Application 2002/0194341). Claim 34 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johnson and Thorne as applied to claim 29 in view of Applicant Admitted Prior Art (AAPA).

II. Examiner Interview

Applicant first wishes to express his sincere appreciation for the time that Examiner Clark spent with Applicant's Attorneys Jeffrey R. Kuester and Benjamin Balser during a December 9, 2004 telephone discussion regarding the above-identified Office Action. Applicant believes that certain important issues regarding the delivery notification options and using Applicant's Admitted Prior Art in combination with a reference were identified during the telephone discussion, and that they are resolved herein. During that conversation, Examiner Clark seemed to indicate that it would be potentially beneficial for Applicant to file this amendment and response. Thus, Applicant respectfully requests that Examiner Clark carefully consider this amendment and response.

III. Miscellaneous Issues

The Office Action rejects claims 20 and 21 under 35 U.S.C. §112 second paragraph. Claim 20 has been amended, adding "means for" such that the rejection under §112 should be withdrawn.

IV. Rejections Under 35 U.S.C. §102(b)

A. Claims 1 and 2

The Office Action rejects claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated by *Johnson* (U.S. Patent No. 5,694,616). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 recites:

1. A method for selectively applying a delivery notification option to an email comprising:

listing email addresses;

selecting a plurality of said email addresses in the course of composing an email message;

selectively applying the delivery notification option to one or more, but not all, of said plurality of email addresses; and

sending the email to said plurality of email addresses.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1 as amended is allowable for at least the reason that *Johnson* does not disclose, teach, or suggest at least **selectively applying the delivery notification option to one or more, but not all, of said plurality of email addresses**. *Johnson* discloses applying priority sorting attributes. *Johnson* does not disclose applying delivery notification options. Notwithstanding, no such teaching can be identified anywhere within this reference. Therefore, *Johnson* does not anticipate claim 1, and the rejection should be withdrawn.

Because independent claim 1 as amended is allowable over the cited references of record, dependent claim 2 (which depends from independent claim 1) is allowable as a matter of law for

at least the reason that dependent claim 2 contains all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claim 2 is patentable over *Johnson*, the rejection to claim 2 should be withdrawn and the claim allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claim 2 recites further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Applicant respectfully contends that no reference or combination thereof discloses or suggests the claim 2 in its entirety. It is respectfully requested that the Examiner give serious consideration to allowing claim 2. Hence there are other reasons why dependent claim 2 is allowable.

B. Claims 15 and 16

The Office Action rejects claims 15 and 16 under 35 U.S.C. § 102(b) as being anticipated by *Johnson* (U.S. Patent No. 5,694,616). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 15 recites:

15. An email system for providing selective application of delivery notification options to individual addresses in a single email, comprising:

means for listing email addresses;

means for selecting a plurality of said email addresses in the course of composing an email message;

means for selectively applying the delivery notification option to one or more, but not all, of said plurality of email addresses; and

means for sending the email to said plurality of email addresses.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 15 as amended is allowable for at least the reason that *Johnson* does not disclose, teach, or suggest at least **means for selectively applying the delivery notification option to one or more, but not all, of said plurality of email addresses**. *Johnson* discloses applying priority sorting attributes. *Johnson* does not disclose applying delivery notification options. Notwithstanding, no such teaching can be identified anywhere within this reference. Therefore, *Johnson* does not anticipate claim 15, and the rejection should be withdrawn.

Because independent claim 15 as amended is allowable over the cited references of record, dependent claim 16 (which depends from independent claim 15) is allowable as a matter of law for at least the reason that dependent claim 16 contains all the steps/features of independent claim 15. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claim 16 is patentable over *Johnson*, the rejection to claim 16 should be withdrawn and the claim allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 15, dependent claim 16 recites further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claim 16 is allowable.

C. Claims 9, 13, and 14

The Office Action rejects claims 9, 13, and 14 under 35 U.S.C. § 102(e) as being anticipated by *Gupta* (U.S. Published Application 2002/0194341). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 9 recites:

9. A method of selectively applying a delivery notification option to addressees in an email, comprising:

- displaying an address book;
- choosing addressees from the address book;
- setting a flag indicating that more than one addressee has been chosen;
- displaying an email delivery notification options selection window if said flag is set;
- selectively applying delivery notification options to each of the addressees***; and
- sending the email.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 9 as amended is allowable for at least the reason that *Gupta* does not disclose, teach, or suggest at least **selectively applying delivery notification options to each of the addresses**. *Gupta* discloses applying priority sorting attributes. *Gupta* does not disclose applying delivery notification options. Notwithstanding, no such teaching can be identified anywhere within this reference. Therefore, *Gupta* does not anticipate claim 9, and the rejection should be withdrawn.

Because independent claim 9 as amended is allowable over the cited references of record, dependent claims 13 and 14 (which depend from independent claim 9) are allowable as a matter of law for at least the reason that dependent claims 13 and 14 contain all the steps/features of independent claim 9. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 13 and 14 are patentable over *Gupta*, the rejection to claims 13 and 14 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 9, dependent claims 13 and 14 recite further features and/or combinations of features, as

are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 13 and 14 are allowable.

D. Claims 23, 27, and 28

The Office Action rejects claims 23, 27, and 28 under 35 U.S.C. § 102(e) as being anticipated by *Gupta* (U.S. Published Application 2002/0194341). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 23 recites:

23. A system for selectively applying a delivery notification option to addressees in an email, comprising:

means for displaying an address book;

means for choosing addressees from the address book;

means for setting a flag indicating that more than one addressee has been chosen;

means for displaying an email delivery notification options selection window if said flag is set;

means for selectively applying delivery notification options to each of the addressees; and

means for sending the email.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 23 as amended is allowable for at least the reason that *Gupta* does not disclose, teach, or suggest at least **means for selectively applying delivery notification options to each of the addresses**. Notwithstanding, no such teaching can be identified anywhere within this reference. Therefore, *Gupta* does not anticipate claim 23, and the rejection should be withdrawn.

Because independent claim 23 as amended is allowable over the cited references of record, dependent claims 27 and 28 (which depend from independent claim 23) are allowable as a matter of law for at least the reason that dependent claims 27 and 28 contain all the steps/features of independent claim 23. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 27 and 28 are patentable over *Gupta*, the rejection to claims 27 and 28 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 23, dependent claims 27 and 28 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 27 and 28 are allowable.

V. Rejections Under 35 U.S.C. §103(a)

A. Claims 3-8

The Office Action rejects claim 3 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Johnson* (U.S. Patent No. 5,694,616) in view of *Shaw* (U.S. Patent No. 6,247,045). The Office Action rejects claim 4 over *Johnson* (U.S. Patent No. 5,694,616) in view of *Collins* (U.S. Published Application 2002/0013817). The Office Action rejects claim 5 over *Johnson* (U.S. Patent No. 5,694,616) in view of *Thorne* (U.S. Patent 5,958,005). The Office Action rejects claims 6 and 7 over *Johnson* (U.S. Patent No. 5,694,616) in view of *Gupta* (U.S. Published Application 2002/0194341). The Office Action rejects claim 8 over *Johnson* (U.S. Patent No. 5,694,616) in view of Applicant Admitted Prior Art (AAPA). For the reasons set forth below, Applicant respectfully traverses the rejections.

Because independent claim 1 is allowable over the cited references of record, dependent claims 3-8 (which depend from independent claim 1) are allowable as a matter of law for at least

the reason that dependent claims 3-8 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 3-8 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 3-8 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 3-8 are allowable.

Moreover, the Office Action cites Applicant's own specification as Applicant's Admitted Prior Art in combination with *Johnson* under 35 U.S.C. §103(a) as disclosing the subject matter of claim 8. However, the Office Action does not provide that *Johnson* discloses any motivation to combine the teachings in *Johnson* with the AAPA. In fact, the Federal Circuit has held that "[i]t is impermissible ... simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template for selecting elements from references to fill the gaps." *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Also "there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Interconnect Planning Corp. v. Feil*, 774 P.2d 1132, 1143 (Fed. Cir. 1985).

B. Claims 10-12

The Office Action rejects claim 10 under 35 U.S.C. §103(a) as being unpatentable over *Gupta* in view of Applicant Admitted Prior Art (AAPA). The Office Action rejects claim 11 over *Gupta* in view of *Shaw* (U.S. Patent 6,247,045). The Office Action rejects claim 12 over *Gupta* in view of *Collins* (U.S. Published application 2002/0013817). For the reasons set forth below, Applicant respectfully traverses the rejections.

Because independent claim 9 is allowable over the cited references of record, dependent claims 10-12 (which depend from independent claim 9) are allowable as a matter of law for at least the reason that dependent claims 10-12 contain all the steps/features of independent claim 9. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir.

2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989).

Therefore, the rejection to claims 10-12 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 9, dependent claims 10-12 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 10-12 are allowable.

Moreover, the Office Action cites Applicant's own specification as Applicant's Admitted Prior Art in combination with *Gupta* under 35 U.S.C. §103(a) as disclosing the subject matter of claim 10. However, the Office Action does not provide that Johnson discloses any motivation to combine the teachings in *Gupta* with the AAPA. In fact, the Federal Circuit has held that "[i]t is impermissible ... simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template for selecting elements from references to fill the gaps." *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Also "there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Interconnect Planning Corp. v. Feil*, 774 P.2d 1132, 1143 (Fed. Cir. 1985).

C. Claims 17-22

The Office Action rejects claim 17 under 35 U.S.C. §103(a) as being unpatentable over *Johnson* (U.S. Patent No. 5,694,616). The Office Action rejects claim 18 over *Johnson* (U.S. Patent No. 5,694,616) in view of *Collins* (U.S. Published Application 2002/0013817). The Office Action rejects claim 19 over *Johnson* (U.S. Patent No. 5,694,616) in view of *Thorne* (U.S. Patent 5,958,005). The Office Action rejects claims 20 and 21 over *Johnson* (U.S. Patent No. 5,694,616) in view of *Gupta* (U.S. Published Application 2002/0194341). The Office Action rejects claim 22 over *Johnson* (U.S. Patent No. 5,694,616) in view of Applicant Admitted Prior Art (AAPA). For the reasons set forth below, Applicant respectfully traverses the rejections.

Because independent claim 15 is allowable over the cited references of record, dependent claims 17-22 (which depend from independent claim 15) are allowable as a matter of law for at least the reason that dependent claims 17-22 contain all the steps/features of independent claim

15. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 17-22 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 15, dependent claims 17-22 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 17-22 are allowable.

Moreover, the Office Action cites Applicant's own specification as Applicant's Admitted Prior Art in combination with *Johnson* under 35 U.S.C. §103(a) as disclosing the subject matter of claim 22. However, the Office Action does not provide that *Johnson* discloses any motivation to combine the teachings in *Johnson* with the AAPA. In fact, the Federal Circuit has held that "[i]t is impermissible ... simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template for selecting elements from references to fill the gaps." *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Also "there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Interconnect Planning Corp. v. Feil*, 774 P.2d 1132, 1143 (Fed. Cir. 1985).

D. Claims 24-26

The Office Action rejects claim 24 under 35 U.S.C. §103(a) as being unpatentable over *Gupta* in view of Applicant Admitted Prior Art (AAPA). The Office Action rejects claim 25 over *Gupta* in view of *Shaw* (U.S. Patent 6,247,045). The Office Action rejects claim 26 over *Gupta* in view of *Collins* (U.S. Published application 2002/0013817). For the reasons set forth below, Applicant respectfully traverses the rejections.

Because independent claim 23 is allowable over the cited references of record, dependent claims 24-26 (which depend from independent claim 23) are allowable as a matter of law for at least the reason that dependent claims 24-26 contain all the steps/features of independent claim 23. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir.

2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 24-26 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 23, dependent claims 24-26 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 24-26 are allowable.

Moreover, the Office Action cites Applicant's own specification as Applicant's Admitted Prior Art in a combination with *Gupta* under 35 U.S.C. §103(a) as disclosing the subject matter of claim 24. However, the Office Action does not provide that Johnson discloses any motivation to combine the teachings in *Gupta* with the AAPA. In fact, the Federal Circuit has held that "[i]t is impermissible ... simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template for selecting elements from references to fill the gaps." *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Also "there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Interconnect Planning Corp. v. Feil*, 774 P.2d 1132, 1143 (Fed. Cir. 1985).

E. Claims 29-34

The Office Action rejects claim 29 under 35 U.S.C. §103(a) as being unpatentable over *Johnson* (U.S. Patent No. 5,694,616) in view of *Thorne* (U.S. Patent No. 5,958,005). The Office Action rejects claim 30 over *Johnson* and *Thorne* in view of *Shaw* (U.S. Patent 6,247,045). The Office Action rejects claim 31 over *Johnson* and *Thorne* in view of *Collins* (U.S. Published Application 2002/0013817). The Office Action rejects claims 32 and 33 over *Johnson* and *Thorne* in view of *Gupta* (U.S. Published Application 2002/0194341). The Office Action rejects claim 34 over *Johnson* and *Thorne* in view of Applicant Admitted Prior Art (AAPA). For the reasons set forth below, Applicant respectfully traverses the rejections.

Because independent claim 29 is allowable over the cited references of record, dependent claims 30-34 (which depend from independent claim 29) are allowable as a matter of law for at least the reason that dependent claims 30-34 contain all the steps/features of independent claim 29. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed.

Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 30-34 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 29, dependent claims 30-34 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 30-34 are allowable.

Moreover, the Office Action cites Applicant's own specification as Applicant's Admitted Prior Art in combination with *Johnson* and *Thorne* under 35 U.S.C. §103(a) as disclosing the subject matter of claim 34. However, the Office Action does not provide that Johnson discloses any motivation to combine the teachings in *Johnson* or *Thorne* with the AAPA. In fact, the Federal Circuit has held that "[i]t is impermissible ... simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template for selecting elements from references to fill the gaps." *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Also "there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Interconnect Planning Corp. v. Feil*, 774 P.2d 1132, 1143 (Fed. Cir. 1985). Therefore, using Applicant's own specification as a motivation to combine is improper and the rejection of claim 34 should be withdrawn for at least this reason.

VI. Cited Art Made of Record

The cited art made of record have been considered, but are not believed to affect the patentability of the presently pending claims. Other statements not explicitly addressed herein are not admitted.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-34 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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